

U.S. Application No.: 10/090,368
Examiner: M.W. Genack
Art Unit: 2617
Response to August 24, 2006 Office Action
Docket: BS01432

REMARKS

In response to the Office Action mailed August 24, 2006, Assignee respectfully requests reconsideration based on the amendments and remarks submitted herewith. Assignee respectfully submits that all pending claims (1-35) are in condition for allowance.

Claims 1-35 are pending. Claims 1, 2, 20, 21, 30 and 31 are amended. No new matter is submitted. Support for the amendments may be found in the Specification at page 3, lines 8-20; page 8, lines 7-16; and page 8, line 26 – page 9, line 9, for example. Accordingly, entry and consideration of the amendments are respectfully requested.

Assignee acknowledges the change to Art Unit 2617 for further examination of this application, as noted in the Office Action.

Rejection of Claims under 35 U.S.C. §102(e)

In the Office Action, claims 1-3, 12, 13, 18-22, 29, 30 and 35 are rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,219,409 to Smith, et al. (hereafter “*Smith*”). The rejection is respectfully traversed.

A claim is anticipated only if each and every element is found in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). See also DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter “M.P.E.P.”).

Claims 1-3, 12, 13, 18-22, 29, 30 and 35 cannot be anticipated by *Smith* because these claims recite features that are not disclosed by *Smith*. Independent claims 1 and 20 are set forth in full above and respectively recite an automated telephone assistant device and an automated telephone assistant method, each comprising, *inter alia*, a base unit in communication with an electronic control device and at least a first algorithm in the base unit. Independent claim 1 more specifically recites “*at least one of the base unit and the electronic control device executing at least a first algorithm entered and modifiable to the base unit by the user through the electronic control device.*” Independent claim 20 similarly recites “*accessing at least a first algorithm within the base unit, the first algorithm entered and modifiable to the base unit by a user through*

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the extension control device and ... executing the first algorithm by at least one of the base unit and the extension control device." Support for such features may be found in the Specification at page 3, lines 8-20; page 8, lines 7-16; and page 8, line 26 – page 9, line 9, for example. *Smith* does not teach or disclose at least the electronic control device in communication with a base unit, whereby a first algorithm is entered and modifiable to the base unit by a user through the extension control device, as recited in each of the pending independent claims 1 and 20.

The Office Action is correct to the extent that *Smith* discloses a premises gateway (PG) (160) that allows a plurality of devices (204-216) connected to a common network (16) to be addressed individually using different transmission media and protocols. See, U.S. Patent No. 6,219,409 to *Smith*, et al. (April 17, 2001) at column 11, line 51 through column 12, line 3. However, *Smith* expressly discloses reliance on interchangeable network interface cards (175) and premise network interface (PNI) cards (187) inserted into slots in the premises gateway (PG) (160), in combination with a central processing unit (CPU) board (186) and subscriber's premises network interface (200a-g), as its incoming signal routing device. *Id.* at column 12, lines 4-29. Thus, the physically interchangeable network interface cards (175) and PNI cards (187) combine with the CPU board (186) and the premises network interface (200a-g) to route incoming signals to a subscriber's device with the capacity to receive that signal's media or protocol. The premises network interface (PNI) (200a-g) relied on in the Office Action as comprising the "*extension control device*" is more accurately a signal router that directs an incoming call to an end device (204-216) through a node, i.e., the PNI (200a-g) devices, from a corresponding PNI communication card (188-198). See, *Id.* at col. 13, lines 60-65. *Smith* however, nowhere indicates that the PNI (200a-g) devices have a capacity to modify an algorithm in an "*extension control device*" as recited in pending claims 1 and 20.

Thus, *Smith* does not disclose the combination of features comprising the automated telephone assistant device and method recited in each of the pending independent claims 1 and 20. All remaining claims ultimately depend from one of claims 1 and 20. *Smith* therefore cannot and does not anticipate each and every feature of claims 1-35. Accordingly, withdrawal of the 35 U.S.C. §102(e) rejection of claims 1-3, 12, 13, 18-22, 29, 30 and 35 based on *Smith* is respectfully requested.

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Rejection of Claims under 35 U.S.C. §103(a)

In the Office Action, claims 4 and 5 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Smith* in view of U.S. Patent No. 5,802,467 to Salazar, et al. (hereafter "*Salazar*"), claims 6-8 and 23-25 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Smith* in view of U.S. Patent No. 6,473,078 to Ikonen, et al. (hereafter "*Ikonen*"), claims 9, 11, 16, 26, 28 and 33 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Smith* in view of U.S. Patent No. 5,978,451 to Swan, et al. (hereafter "*Swan*"), claims 10 and 27 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Smith* in view of U.S. Patent No. 6,823,354 to Kynast, et al. (hereafter "*Kynast*"), claims 14, 15, 31 and 32 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Smith* in view of U.S. Patent Application Publication 2001/0003706 to Warburton, et al. (hereafter "*Warburton*"), and claims 17 and 34 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *Smith* in view of U.S. Patent No. 6,122,347 to Borland (hereafter "*Borland*"). For the following reasons, these 35 U.S.C. §103(a) rejections are respectfully traversed.

1. ***Smith* "Teaches Away" and Cannot Support a *Prima Facie* Case of Obviousness**

Smith "teaches away" from the pending claims. A reference that 'teaches away' from the claimed invention is a significant factor when determining obviousness. See Manual of Patent Examiner Procedures at §2145 (X)(D)(1) (hereafter "MPEP"). A reference must be considered as a whole, including portions that lead away from the claimed invention. See *id.* at §2143.02; see also *W.L. Gore & Assoc., Inc. v. Garlock, Inc.* 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "It is improper to combine references where the references teach away from their combination." MPEP at §2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. See MPEP at §2143.01.

The Office Action's alleged *prima facie* case requires impermissible changes to the principle of operation of *Smith*. As explained above, *Smith* discloses a premises gateway (PG) (160) that allows a plurality of end devices (204-216) connected to a common network (16) to be addressed individually using different transmission media and protocols. See, U.S. Patent No.

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6,219,409 to Smith, et al. (April 17, 2001) at column 11, line 51 through column 12, line 3. *Smith* further discloses reliance on interchangeable network interface cards (175) and premise network interface (PNI) cards (187) inserted into slots in the premises gateway (PG) (160), in combination with a central processing unit (CPU) board (186) and subscriber's premises network interface (200a-g), as its incoming signal routing device. *Id.* at column 12, lines 4-29. Thus, the physically interchangeable network interface cards (175) and PNI cards (187) combine with the CPU board (186) and the premises network interface (200a-g) to route incoming signals to a subscriber's device with the capacity to receive that signal's media or protocol. The premises network interface (PNI) (200a-g) relied on in the Office Action as comprising the "extension control device" is more accurately a signal router that directs an incoming call to an end device (204-216) through a node, i.e., the PNI (200a-g) devices, from a corresponding PNI communication card (188-198). See, *Id.* at col. 13, lines 60-65. *Smith* however, nowhere indicates that the PNI (200a-g) devices have a capacity to modify an algorithm in an "extension control device" as recited in pending claims 1 and 20.

To the extent that the PNI devices (200a-g) of *Smith* do not modify an algorithm as in the claimed "extension control device" of pending independent claims 1 and 20, then one reasonable skilled in the art would most reasonably understand that re-programming of the CPU board (186) is required to change the routing of signals through a PNI (200a-g) device, i.e., node. Such re-programming of the central CPU board (186) in *Smith* to change signal routing through a node is significantly different than the algorithm modification technique of the "extension control device" recited in pending claims 1 and 20. The CPU re-programming requirement of *Smith* thus teaches away from the "extension control device" algorithm modification technique recited in each of the pending independent claims 1 and 20. To modify the PNI (200a-g) devices of *Smith* to provide algorithm modification capacities and eliminate CPU re-programming for changing signal routing would alter the principle of operation of *Smith*. The patent laws, however, forbid such changes to support an obviousness rejection. *Smith* thus teaches away from the pending claims and cannot be used to support a *prima facie* case of obviousness in combination with any of *Salazar*, *Ikonen*, *Swan*, *Kynast*, *Warburton* and *Borland*. Accordingly, withdrawal of the 35 U.S.C. §103(a) rejections of claims 4-11, 14-17, 23-28 and 31-34 based on the combination of

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Smith with any of *Salazar*, *Ikonen*, *Swan*, *Kynast*, *Warburton* and *Borland* is respectfully requested.

2. Because No Reasonable Expectation of Success was Cited, the *Prima Facie* Case Fails

The Office Action's alleged *prima facie* case based on *Smith* in combination with any of *Salazar*, *Ikonen*, *Swan*, *Kynast*, *Warburton* and *Borland* is defective. A *prima facie* case for obviousness must include "a reasonable expectation of success." MPEP at §2143. Here, however, no basis for successfully combining *Smith* with any of *Salazar*, *Ikonen*, *Swan*, *Kynast*, *Warburton* and *Borland* to provide an "extension control device" with the capacity for executing and modifying an algorithm, as recited in pending independent claims 1 and 20 has been cited in the Office Action. All other claims ultimately depend from one of claims 1 and 20. That which the Office Action relies on", i.e., the PNI devices (200a-g) of *Smith*, as the claimed "electronic control device" is more accurately a signal router. No other reference was applied for teaching or suggesting this feature or capability, thus no reasonable expectation of success of combining the applied references to teach or suggest the combination of features claimed is evident in the Office Action. Because the Office Action has failed to make such a finding, then a *prima facie* case of obviousness has not been established. Due Process therefore requires the withdrawal of the 35 U.S.C. §103(a) rejection of claims 4-11, 14-17, 23-28 and 31-34 based on any combination of *Smith* in view of any of *Salazar*, *Ikonen*, *Swan*, *Kynast*, *Warburton* and *Borland*.

CONCLUSION

In view of the remarks and amendments set forth herein, Assignee submits that none of the references cited by the Office, alone or in combination, teach, disclose or suggest the combination of features claimed. Therefore, Assignee respectfully solicits a Notice of Allowance for all pending claims (claims 1-35).

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Of course, should the Examiner determine that anything further is desirable to place this application in even better form for allowance, the Examiner is invited to contact the undersigned at (757) 253-5729 (office), (757) 784-1978 (cellular), or bambi@wzpatents.com.

Respectfully submitted,



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